



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,559	12/19/2000	Bridget D. Kimball	D02311-P01	4506
43471	7590	12/22/2008	EXAMINER	
Motorola, Inc. Law Department 1303 East Algonquin Road 3rd Floor Schaumburg, IL 60196			DAVIS, ZACHARY A	
			ART UNIT	PAPER NUMBER
			2437	
			NOTIFICATION DATE	DELIVERY MODE
			12/22/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Docketing.US@motorola.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/740,559	<b>Applicant(s)</b> KIMBALL ET AL.	
	<b>Examiner</b> Zachary A. Davis	<b>Art Unit</b> 2437	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9,10,12 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9,10,12 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. As noted in the advisory action mailed 24 September 2008, the reply filed 11 September 2008 was previously entered. By that reply, Claims 27 and 28 were amended.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09 October 2008 has been entered.
3. By the above submission, Claims 9, 10, 12, and 27-29 have been amended. No claims have been added or canceled. Claims 9, 10, 12, and 27-29 are currently pending in the present application.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 9, 10, 12, and 27-29 have been considered but are moot in view of the new ground(s) of rejection. The Examiner notes that the new grounds of rejection are made in light of the amendments to the claims,

Art Unit: 2437

and should not be taken as acquiescence to any of the arguments presented by Applicant in the present response.

### ***Specification***

5. The objection to the specification for failure to provide proper antecedent basis for the claimed subject matter is withdrawn in light of the amendments to the claims.

### ***Claim Objections***

6. As noted in the advisory action mailed 24 September 2008, the objection to Claims 27 and 28 for informalities is withdrawn in light of the amendments to the claims.

7. Claim 9 is objected to because of the following informalities:

Claim 9 recites “said first authorization message” in line 13 of the claim. It is noted that this appears to be intended to refer to the “authorization message” of line 6; however, there is no “first authorization message” explicitly recited elsewhere in the claim.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The rejection of Claims 9, 10, 12, and 27-29 under 35 U.S.C. 112, first paragraph, for failure to comply with the written description requirement is withdrawn in light of the amendments to the claims. The rejection of Claims 9, 10, 12, and 27-29 under 35 U.S.C. 112, second paragraph, as indefinite, is NOT withdrawn because, although the amendments have addressed the issues of indefiniteness noted in the previous Office action, the amendments have also raised new issues of indefiniteness as set forth below.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 9, 10, 12, and 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation “said set top box” in lines 8-9, 10-11, and 12, and “the set top box” in lines 17-18. However, the claim also recites both “a set top box” in lines 3-4 and “a plurality of separate set top boxes” in line 7. Because there are multiple set top boxes referred to, it is not clear to which of the set top boxes the limitation “said set top box” is intended to refer. This renders the claim indefinite. It is noted that the recitation of “said set top box” in lines 4-5 and 6 of the claim are not indefinite because there is only one set top box noted prior to these limitations. It is further noted that, for purposes of interpreting the prior art, the later limitations of “said set top box” are

Art Unit: 2437

assumed to refer to the first mentioned set top box of lines 3-4 and not to the any of the plurality of separate set top boxes.

Claims 10, 12, and 27-29 are rejected due to their dependence on rejected Claim 9.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 9, 10, 12, and 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Safadi et al, US Patent 6256393.

In reference to Claim 9, Safadi discloses a method that includes receiving a rights message with a set top box, where the rights message individually conveys access rights to the set top box for a functional unit (column 3, lines 23-25, 28-29, and 41-43; column 6, line 38-column 7, line 2, where EMM conveys rights for software objects and terminal resources); receiving an authorization message with the set top box, where the authorization message is transmitted to a plurality of separate set top boxes and specifies required rights for use of a separately received software object by

Art Unit: 2437

the first set top box (column 3, lines 20-23, 27-28, and 34-40; column 5, lines 30-50, where the ECS contains access requirements; column 5, line 64-column 6, line 12, where the ECS is sent to the set top boxes independently from the software objects); determining whether the first set top box is authorized to access the software object by comparing the access rights conveyed in the rights message with the required rights specified by the authorization message (column 3, lines 20-32; column 7, lines 19-26, where the access rights are compared with the authorization requirements); and blocking access by the set top box to the software object as a function of the determination of whether the set top box is authorized to access the software object (column 3, lines 20-32, and column 7, lines 19-26, as above; see also column 7, lines 30-34, where the use of the object is only allowed if a check passes; column 9, lines 5-17, where use of the requested resource is disallowed if the EMM does not provide permission for use).

In reference to Claim 10, Safadi further discloses blocking the software object by ignoring a portion of a datastream associated with the software object (see Figure 3, step 160, where the object is not utilized; see also column 7, lines 40-43 and 58-62; column 8, lines 11-16 and 20-25, where the object is not downloaded and/or utilized).

In reference to Claims 12 and 29, Safadi further discloses that the software object can include a software program or firmware (column 4, lines 1-4, where software objects can include applications or operating systems, *inter alia*; see also column 1, lines 9-16, where a software object can include BIOS, which is firmware).

In reference to Claims 27 and 28, Safadi further discloses that the software object can include video or audio content (column 4, lines 35-41, where audiovisual services are included).

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Safadi et al, WIPO Publication WO00/50978, is the publication of the international application corresponding to US 6256393, cited above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571)272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2437

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Zachary A Davis/  
Examiner, Art Unit 2437